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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,922	10/19/2001	Theresa A. Deisher	96-20D2	7962

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EXAMINER

SAOUD, CHRISTINE J

ART UNIT PAPER NUMBER

1647

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/037,922

Applicant(s)

DEISHER ET AL.

Examiner

Christine J. Saoud

Art Unit

1647

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 and 21-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13 and 21-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Upon reconsideration, prosecution is being reopened in order to apply a new ground of rejection. The delay in making this ground of rejection is regretted.

Claims 8-13 and 21-35 are currently pending and under examination.

Specification

Applicant's submission of the paper copy of the Sequence Listing is noted. This corrects the previously noted deficiencies.

The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The title of the invention is objected to because a polypeptide does not encode a protein – rather, it is the protein. The title should be amended to remove the “encoding” recitation.

The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. See page 15, line 16. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01.

Page 15 line 1 and page 19, line 12 contain amino acid sequences with no reference to a Sequence identifier. See 37 CFR 1.821(d). Correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 33-35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Upon review of the instant specification, no basis for the a polypeptide comprising amino acids 58 to 175 of SEQ ID NO:2 could be found. Claims to these polypeptides appear to be new matter. Support for these claim limitations should be pointed out, by page and line number.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

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A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 8-13 and 21-35 are rejected on the ground of nonstatutory double patenting over claims 1-5 of U. S. Patent No. 6,352,971 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claims are all directed to FGF molecules of SEQ ID NO:2 and pharmaceutical compositions thereof. The polypeptide of SEQ ID NO:2 from residue 28 to residue 196 in '971 would clearly encompass the instant claims of an isolated FGF homolog polypeptide comprising an amino acid sequence of SEQ ID NO:2 from residue 28 to residue 175 and molecules with 80% greater identity, and vice versa. Therefore, the instant claims would improperly extend the "right to exclude" already granted in the patent.

Claims 8-13 and 21-35 are rejected on the ground of nonstatutory double patenting over claims 1-3 of U. S. Patent No. 6,518,236 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claims are all directed to FGF molecules of SEQ ID NO:2 and pharmaceutical compositions thereof. The polypeptide of SEQ ID NO:2 from residue 28 to residue 175 and from residue 55 to residue 175 in '236 would clearly encompass the instant claims of an isolated FGF homolog polypeptide comprising an amino acid sequence of SEQ ID NO:2 from residue 28 to residue 175 and molecules with 80% or greater identity, and vice versa. Therefore, the instant claims would improperly extend the "right to exclude" already granted in the patent.

Claims 9-10 and 23-35 are rejected on the ground of nonstatutory double patenting over claims 1-3 of U. S. Patent No. 6,352,971 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: the claims are all directed to FGF molecules of SEQ ID NO:2 and pharmaceutical compositions thereof. The polypeptide of SEQ ID NO:2 from residue 28 to residue 196 in '971 would clearly encompass the instant claims of an isolated FGF homolog polypeptide comprising an amino acid sequence of SEQ ID NO:2 from residue 28 to residue 196 and molecules with 80% or greater identity, and vice versa. Therefore, the instant claims would improperly extend the "right to exclude" already granted in the patent.

The instant claims and those of the issued patents are of overlapping scope. The specifically recited embodiments of particular polypeptides (i.e. comprising an amino acid sequence of SEQ ID NO:2 from residue 28 to residue 175, from residue 28 to residue 196, from residue 28 to 207) are identical, and therefore, constitute common subject matter. Therefore, the instant claims would improperly extend the "right to exclude" already granted in the patent.

Conclusion

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christine J. Saoud whose telephone number is 571-272-0891. The examiner can normally be reached on Monday-Friday, 6AM-2PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback can be reached on 571-272-0961. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

CHRISTINE J. SAOUD
PRIMARY EXAMINER

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